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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,863	12/21/2000	Howard Shelton Lambert	GB999141US1	2220

46369 7590 04/11/2006

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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT PAPER NUMBER

2134

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/745,863	LAMBERT ET AL.	
Examiner	Art Unit	
Michael J. Simitoski	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response of 3/13/2006 has been received and considered.
2. Claims 1-16 are pending.

Response to Arguments

3. In light of Applicant's amendments to claim 5, the rejection under 35 U.S.C. §112, set forth in the previous Office Action, is withdrawn.
4. Applicant's response (p. 7, ¶3) argues that "Peinado et al. reveals that the black box does not send a decoding process attribute request. Instead, it is the license evaluator 36 (Fig. 4), a different component from the black box with a different purpose, that requests a license from the license server." However, nothing in the claim suggests that the decoding controller perform only certain functions. As such, the DRM system of Peinado performs the functions of the black box in addition to the license evaluator. Therefore, at least the claimed decoding controller is being compared with Peinado's DRM system, which contains the black box. Therefore, the rejection is maintained.
5. Applicant's response (p. 8, ¶3) argues that Marvit "reveals no disclosure regarding what component of a "user" is requesting the decrypting key from the key repository. Indeed, Applications could find no disclosure anywhere in Marvit et al. regarding what component is performing the requesting. Instead, the absence of any specific appears purposeful, in light of the very general description of "user" at column 4, lines 2-9." However, col. 4, lines 2-9 disclose that the user is, for instance, a client. Therefore, there is nothing in the claims to differentiate the client in Marvit from, for instance, the decoding controller of the claims, as the actions claimed are performed by Marvit's client/personal computer. Furthermore, starting at col. 20, §B, Marvit

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gives an extensive example of implementation hardware for performing the actions of the invention disclosed. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 4 & 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,775,655 to Peinado et al. (**Peinado**).

Regarding claims 1 & 7, Peinado discloses in response to a request from a requestor for access to data stored in an encoded form on a first digital processing apparatus/user's computing device (Fig. 1, col. 2, lines 53-62 & col. 14, lines 1-12), sending a request from a decoding controller/black box on the first data processing apparatus/user's computing device to a second data processing apparatus/license server to determine attributes/license of a decoding process for accessing the encoded data (col. 18, lines 26-53, col. 19, lines 17-18, lines 33-40 & col. 21, lines 36-45), in response to said request to the second data processing apparatus, receiving said determined attributes/license at said decoding controller/black box (col. 21, lines 36-45), performing the decoding process in accordance with the determined attributes/license (col. 23, lines 46-55).

Regarding claim 2, Peinado discloses the requestor communicating via an application-programming interface with a data access manager/DRM system (Fig. 5B, #511 & col. 13, lines 46-57).

Regarding claim 4, Peinado discloses the attribute containing an identifier of a compressor (col. 29, lines 60-65).

Regarding claim 5, Peinado discloses checking whether program code implementing said identified one or more of a cryptor/black box, a compressor and an authenticator is stored on the first data processing apparatus (Fig. 7, #711 & 30) and if not, initiating downloading of the respective program code from the second data processing apparatus or another data processing apparatus/black box server (Figs. 7-8).

Regarding claims 8 & 13, Peinado discloses logging requests (col. 21, lines 35-39).

Regarding claims 9 & 14, Peinado discloses means for authenticating the requestor before retrieving the stored attributes (Fig. 5A & Fig. 7).

Regarding claim 10, Peinado discloses in response to a request from a requestor/user for access to data stored in an encoded form on a first data processing apparatus/user's computing device (col. 2, lines 53-62), sending a request from a decoding controller/DRM system containing black box on the first data processing apparatus/user's computing device to a second data processing apparatus/license server to determine attributes/license of a decoding process for accessing the encoded data (col. 18, lines 26-53, col. 19, lines 17-18, lines 33-40 & col. 21, lines 36-45), in response to said request to the second data processing apparatus/license server, receiving said determined attributes at said decoding controller/DRM system containing black

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box (col. 21, lines 36-45), performing the decoding process in accordance with the determined attributes (col. 23, lines 46-55).

Regarding claim 11, Peinado discloses a processing unit/user's computing device, data storage means/user's computing device (Fig. 12), communication means (Fig. 12) for sending and receiving communications from data processing systems connectable to said first data processing apparatus via a network (col. 2, lines 53-62) and a decoding controller/DRM system containing black box, responsive to a request from a requestor/user for access to data stored in an encoded form in said data storage means (col. 2, lines 53-62), for sending a request via said communication means to a second data processing apparatus/license server (col. 18, lines 26-53, col. 19, lines 17-18, lines 33-40 & col. 21, lines 36-45) to determine attributes/license of a decoding process for accessing the encoded data and for receiving said determined attributes via said communication means (col. 18, lines 26-53, col. 19, lines 17-18, lines 33-40 & col. 21, lines 36-45), wherein the decoding controller/DRM system containing black box is adapted to control the operation of the processing unit to perform the decoding process in accordance with the determined attributes/license (col. 23, lines 46-55).

Regarding claim 12, Peinado discloses a processing unit (Fig. 12), data storage means storing attributes of one or more decoding processes, which processes are associated with specific data stored in an encoded form on the data processing apparatus/license server (col. 2, lines 53-62) and an access controller component/license server for retrieving the stored attributes from memory in response to a request from a remote data processing apparatus/user's computing device and for sending the retrieved attributes to the data processing apparatus/user's computing device (col. 18, lines 26-53, col. 19, lines 17-18, lines 33-40 & col. 21, lines 36-45).

Regarding claim 15, Peinado disclose negotiating said attributes/license prior to said receiving (Fig. 7).

Regarding claim 16, Peinado discloses said attributes changing for a subsequent requestor session (col. 21, lines 46-62).

8. Claims 1, 3 & 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,625,734 to Marvit et al. (**Marvit**).

Regarding claims 1, 7 & 10-14, Marvit discloses in response to a request from a requestor/user/personal computer (col. 4, lines 2-9 & col. 20, line 28 – col. 21, line 65) for access to data/message stored in an encoded form on a first data processing apparatus/user 102's computer (col. 5, lines 57-63) (which contains a storage medium (col. 20, line 28 – col. 21, line 65) and executes software (col. 20, line 28 – col. 21, line 65)), sending a request from a decoding controller/processor on the first data processing apparatus/computer (col. 20, line 28 – col. 21, line 65) to a second data processing apparatus/key repository to determine attributes/keys of a decoding process for accessing the encoded data (col. 5, lines 57-63), in response to said request to the second data processing apparatus, receiving said determined attributes/key at said decoding controller (col. 6, lines 1-2) and performing the decoding process in accordance with the determined attributes/key (col. 6, lines 3-6).

Regarding claim 3, Marvit discloses wherein the received attributes/keys are stored in volatile memory of the first data processing apparatus when received (Fig. 11, col. 6, lines 1-6, col. 16, lines 44-47, col. 21, line 1), and are deleted from said memory at the end of a current requestor session, such that a request to determine attributes of a decoding process must be

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repeated for each requestor session for which access to encoded data is required (col. 6, lines 4-6 & lines 35-40).

Regarding claim 8, Marvit discloses logging said requests to determine attributes (col. 7, lines 62-63).

Regarding claim 9, Marvit discloses authenticating the requestor (col. 5, lines 22-26).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Peinado**, as applied to claim 1 above, in view of U.S. Patent 6,421,726 to Kenner et al. (**Kenner**).

Regarding claim 6, as best understood, Peinado lacks checking whether program code implementing said compressor is stored on the first data processing apparatus and if not, initiating downloading of the respective program code. However, Kenner teaches a system where if a CODEC is not available on the system, the system can automatically download a CODEC/program code that will decode the media (col. 18, line 66 – col. 19, line 5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peinado to check whether program code implementing the compressor is stored on the first data processing apparatus/user's computing device and if not, initiating downloading of the respective program code/CODEC. One of ordinary skill in the art would have been

motivated to perform such a modification to automatically install a necessary CODEC, as taught by Kenner (col. 18, line 66 – col. 19, line 5).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference to AAP is cited for teaching rights management and the limitations that can be imposed (example p. 34).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis Jacques can be reached at (571) 272-6962.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300
(for formal communications intended for entry)

Or:

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

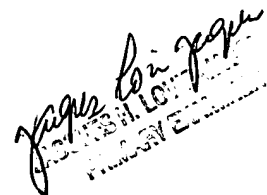
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJS



April 3, 2006



JACQUES LOUIS JACQUES
PATENT EXAMINER
ART UNIT 2134